Docket No.: 13111-00035-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Rainer Stürmer et al.	Conf. No.: 4511
Application No.: 10/573,130	Group Art Unit: 1625
Filed: March 23, 2006	Examiner: Taofiq A. Solola

For: METHODS FOR THE PRODUCTION OF 3-METHYLAMINO-1-(THIENE-2-YL)-PROPANE-1-OL

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 26, 2007, Applicants provisionally elect Group III (claims 20-26), drawn to an enzymatic process of making, with traverse. Additionally, Applicants respectfully request that at least claims 7-10 be examined together with Group III. Reconsideration and withdrawal of the restriction requirement is strongly urged for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. An application "shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." (PCT Rule 13.1). Unity of invention is fulfilled "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression 'special technical feature' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (PCT Rule 13.2).

The Examiner alleges that the only structural element shared by Groups I-III is 3-methylamino-1-(thien-2-yl)propan-1-ol, and that because it is well known in the art, citing

Kumiyoshi *et al.* (JP03/192681; hereinafter "Kumiyoshi"), it does not constitute a corresponding special technical feature. The standard under unity is not whether or not there is a structural element shared by the groups but rather whether there is a general inventive concept and whether there is a technical relationship among those inventions. Furthermore the "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art, not simply an individual element as alleged by the Patent Office.

As described in the specification and recited in the claims, the general inventive concept of the present application relates to processes for preparing 3-methylamino-1-(thien-2-yl)propan-1-ol of formula I comprising several steps including reacting with a hydrogen halide. Kumiyoshi *et al.* (D1 in the International Preliminary Report on Patentability (IPRP)) does teach or disclose such a method as noted in the IPRP. Therefore, Kumiyoshi does not disclose the method of the invention as claimed. The Patent Office has not established the presence in the prior art of Applicants' invention as claimed. Because Kumiyoshi does not establish the general inventive concept or the special technical feature of the present invention, Applicants respectfully request that the restriction requirement be reconsidered and all the claims be examined in one application.

Additionally, Applicants respectfully request that at least claims 7-10 be examined together with Group III rather than with Group I. The Examiner has characterized Group I as being drawn to a non-enzymatic process of making and Group III as being directed to an enzymatic process of making. Claims 7-10 are drawn to a process of making using an enzyme. Because claims 7-10 are drawn to an enzymatic process of making as are the claims of Group III, claims 7-10 should also be included with the claims of Group III.

The Examiner has also required restriction between product (Group II) and process claims (Group I or III). However, under the application standard, unity of invention is further fulfilled because the claims are directed to a product and a process of use of said product, which are an acceptable combination of categories for unity pursuant to 37 CFR § 1.475(b)(2). Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement as to Groups II and III and also examine claims 7-10 and the claims of at least

Group II (drawn to an enzyme) with the claims of Group III (drawn to a method using the enzyme) in one application.

Furthermore, Applicants believe that there is no undue burden on the Examiner to search and examine at least claims 7-10 and Groups II and III. Because the same art would be relevant to a method of using the enzyme as with the enzyme, there would be no undue burden on the Examiner to search and examine at least claims 7-10 and Groups II and III together. Moreover, because the claims were searched and examined by the International Search Authority and no lack of unity of invention was found between claims 5 and 7-26, there would appear to be no undue burden on the Examiner to examine the entire application or examine at least claims 7-10 and Groups II and III together for this additional reason.

CONCLUSION

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn and that all the claims be examined in one application. Additionally, Applicants respectfully request that at least claims 7-10 be considered part of Group III and be examined together with the provisionally elected claims of Group III. In the alternative, pursuant to 37 CFR § 1.475(b)(2), Applicants respectfully request that claims 7-10 and Groups II and III be examined in one application.

Applicants are submitting their response within the one-month response period. No fee is believed due. However, if any fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13111-00035-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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